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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,582	07/31/2001	Andrew Carl Root	ENL-275-A	2198

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Young & Basile PC
Suite 624
3001 West Big Beaver Road
Troy, MI 48084-3107

EXAMINER

COURSON, TANIA C

ART UNIT	PAPER NUMBER
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2859

DATE MAILED: 03/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/918,582

Applicant(s)

ROOT, ANDREW CARL

Examiner

Tania C. Courson

Art Unit

2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 8, 9, 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-17 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. The election requirement stated in the Office Action found in Paper No. 4 is hereby repeated and thus made FINAL.
2. Claims 8-9 remain withdrawn from further consideration as being drawn to a nonelected invention, there being no allowable generic or linking claim. Newly introduced claims 18-19 are also withdrawn from consideration since they too would be drawn to the nonelected invention.
3. Thus, claims 1-7, 10-17 and 20 will be further examined in this action.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPFP § 608.01 (o). Correction of the following is required:
 - a) Claims 11-13 recite the limitation "a forefront area of a sole of the foot" in lines 6, 13 and 6, respectively, although the specification recites on page 5, line 22, "the sole of a patient's foot" not "a forefront area".

Claim Objections

5. Claims 11-14 and 20 are objected to because of the following informalities:

Art Unit: 2859

- a) claims 11-14 and 20, "mold" should read "mould" and "moulding" should read "moulding" to be consistent with the language found in the originally filed claims 1-10 which indicate the British spelling.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens (US 3,020,909).

Stevens discloses a limb supporting device including the following:

- a) a member (Fig. 2, foot supporting plate 54) having a planar surface on one side (Fig. 2);
- b) operating means (Fig. 2, set screw 60) provided on the opposite side of the said member (Fig. 2) to said planar surface said operating means further providing means for tilting the said member (column 4, lines 31-32) while the planar surface is in contact with the foot sole (Fig. 9).

Art Unit: 2859

Stevens does not disclose for operation of the member in the pressure application of the planar surface into contact with at least a part of the sole of a foot suitably positioned therein, for appropriate support and joint or other location of the foot sole during the application and setting of moulding material to at least the sole of the foot.

With respect to the intended use of the apparatus, e.g. for operation of the member in the pressure application of the planar surface into contact with at least a part of the sole of a foot suitably positioned therein, for appropriate support and joint or other location of the foot sole during the application and setting of moulding material to at least the sole of the foot: It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

8. Claims 2-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens, as applied to claim 1 as stated above, and further in view of Donnery (US 4,771,548).

Stevens disclose a limb supporting device as stated above in paragraph 7. Stevens further discloses the device including, a leg rest (Fig. 9. limb supporting plate 36), said member being, movably mounted from the leg rest (Fig. 9), said member being hingedly/pivotally mounted from the leg rest (Fig. 9).

Stevens does not disclose a member carrying means for measuring and indicating the angle of angular movement/tilt of the said member and its planar surface about the substantially vertical axis.

Donnery teaches a member carrying means for measuring and indicating the angle of angular movement/tilt of the said member and its planar surface about the substantially vertical axis (Fig. 1, goniometer 10). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the limb supporting device of Stevens, so as to include a member carrying means for measuring and indicating the angle of angular movement/tilt of the said member and its planar surface about the substantially vertical axis, as taught by Donnery, so as to provide a means for facilitating objective and consistent assessment of angular movement.

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens, as applied to claim 1 as stated above, and further in view of Fullen et al. (US 5,678,448).

Stevens discloses a limb supporting device, as stated above in paragraph 7.

Stevens does not disclose operating means for measuring and indicating the pressure of application of the said member when the planar surface thereof is in contact with the foot sole.

Fullen et al. teach operating means for measuring and indicating the pressure of application of the said member when the planar surface thereof is in contact with the foot sole (Fig. 2 and column 5, lines 64-69). Therefore, it would have been obvious to one having ordinary

Art Unit: 2859

skill in the art at the time the invention was made to further modify the limb supporting device of Stevens, so as to include operating means for measuring and indicating the pressure of application of the said member when the planar surface thereof in contact with the foot sole, as taught by Fullen et al., so as to provide a compact force measurement system for minimizing restriction of movement by the user during use of the device.

10. Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens, as applied to claim 1 as stated above, and further in view of Tatum et al. (US 5,908,397).

Stevens discloses a limb supporting device, as stated above in paragraph 7. Stevens further discloses the following:

- a) a method of applying the planar surface of a member by pressure application to at least part of the sole of a foot (Fig. 9), and;
- b) tilting the member while its planar surface is in contact with the foot sole.

Stevens does not disclose a method of taking a mould of a foot comprising applying moulding material to at least the foot sole, allowing the moulding material to set while the foot is supported, and withdrawing the planar surface from contact with the foot sole and effecting removal of the set moulding material from the foot.

Tatum et al. teach a method of taking a mould of a foot comprising applying moulding material to at least the foot sole, allowing the moulding material to set while the foot is supported, and withdrawing the planar surface from contact with the foot sole and effecting removal of the set moulding material from the foot (column 3, lines 10-13 and column 13, lines

Art Unit: 2859

22-31). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the limb supporting device of Stevens, so as to include a method of taking a mould of a foot, as taught by Tatum et al., so as to provide an additional use for the limb supporting device in order to reduce the manual labor on the part of the nurse/attendant.

11. Claims 11-13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens.

Stevens discloses a limb supporting device including the following:

- a) a member (Fig. 2, foot supporting plate 54) having a planar surface on one side (Fig. 2);
- b) operating means (Fig. 2, set screw 60) provided on the opposite side of the said member to said planar surface (Fig. 2);
- c) a leg rest (Fig. 9, limb supporting plate 36);
- d) said member being movably mounted from the leg rest (Fig. 9), and;
- e) said member being hingedly/pivotally mounted from the leg rest (Fig. 9).

Stevens does not disclose for operation of the member in the pressure application of the planar surface, for the purposes and also for tilting said member about a vertical axis, for placing on a seat or couch, for movement to or from an operative contact position and for angular movement about a substantially vertical axis.

Art Unit: 2859

*With respect to the intended use of the apparatus, e.g. for operation of the member in the pressure application of the planar surface, for the purposes and also for tilting said member about a vertical axis, for placing on a seat or couch, for movement to or from an operative contact position and for angular movement about a substantially vertical axis: It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

12. Claims 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens, as applied to claims 11-13 and 15, as stated above, and further in view of Donnery.

Stevens disclose a limb supporting device as stated above in paragraph 11.

Stevens does not disclose a member carrying means for measuring and indicating the angle of angular movement/tilt of the said member and its planar surface about the substantially vertical axis.

Donnery teaches a member carrying means for measuring and indicating the angle of angular movement/tilt of the said member and its planar surface about the substantially vertical axis (Fig. 1, goniometer 10). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the limb supporting device of Stevens, so as to include a member carrying means for measuring and indicating the angle of angular movement/tilt of the said member and its planar surface about the substantially vertical

Art Unit: 2859

axis, as taught by Donnery, so as to provide a means for facilitating objective and consistent assessment of angular movement.

13. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens, as applied to claims 11-13 and 15 as stated above, and further in view of Fullen et al.

Stevens discloses a limb supporting device, as stated above in paragraph 11.

Stevens does not disclose operating means for measuring and indicating the pressure of application of the said member when the planar surface thereof is in contact with the foot sole.

Fullen et al. teach operating means for measuring and indicating the pressure of application of the said member when the planar surface thereof is in contact with the foot sole (Fig. 2 and column 5, lines 64-69). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the limb supporting device of Stevens, so as to include operating means for measuring and indicating the pressure of application of the said member when the planar surface thereof is in contact with the foot sole, as taught by Fullen et al., so as to provide a compact force measurement system for minimizing restriction of movement by the user during use of the device.

Double Patenting

14. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same

Art Unit: 2859

"invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

15. Claim 20 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 10.

When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Response to Arguments

16. Applicant's arguments filed January 29, 2003 have been considered but are moot in view of the new ground(s) of rejection.

17. The examiner spoke with the applicant's attorney on March 25, 2003 to confirm that claims 1-10 had not been cancelled. as is stated on page 6, lines 1-2, of the Applicant's Arguments filed on January 29, 2003.

18. In response to applicant's argument that the references fail to show certain features of

Art Unit: 2859

applicant's invention, it is noted that the features upon which applicant relies (i.e., applying pressure to the forefront of the sole) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tania C. Courson whose telephone number is (703) 305-3031. The examiner can normally be reached on Monday-Friday from 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez, can be reached on (703) 308-3875. The fax number for this Organization where this application or proceeding is assigned is (703) 308-7724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



DIEGO F.F. GUTIERREZ
SUPERVISORY PATENT EXAMINER
GROUP ART UNIT 2859

TCC
March 27, 2003